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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,396	07/13/2001	Patrick H. Hayes	81230.62US4	5769
34018	7590	09/21/2004	EXAMINER	
GREENBERG TRAURIG, LLP 77 WEST WACKER DRIVE SUITE 2500 CHICAGO, IL 60601-1732			CHEN, ALAN S	
			ART UNIT	PAPER NUMBER
			2182	

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/905,396	Applicant(s) HAYES ET AL.	
	Examiner Alan S Chen	Art Unit 2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 and 35 is/are pending in the application.
 4a) Of the above claim(s) 34 and 36-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-33 and 35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 34 and 36-55 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1,2,3,6,9,12,22,26,31 and 35 are drawn to an invention, classified in class 345, subclass 760.
 - II. Claims 34 and 36, drawn to an invention, classified in class 710, subclass 12.
2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because claims 34 and 36 do not require a mark-up tags, only some form of command code. The subcombination has separate utility such as a web control of peripheral device through any controlling device that has a browser and mark-up language, not necessarily being a remote control.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. During a telephone conversation with Gary Jarosik (Reg. No. 35906) on 09/10/2004 a provisional election was made without traverse to prosecute the invention of group I, claims 1-33 and 35. Affirmation of this election must be made by applicant in replying to this Office action. Claims 34 and 36-55 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1,3-21,26-30 and 35 rejected under 35 U.S.C. 101 because they contain non-functional descriptive material, specifically the following:

Claims 1, 9-11, 12-21 and 26-30 recite a readable media and associated limitations to a readable media which can, for instance, be information/code on a piece of paper.

Claims 3-5 recite a electrical signal which can be any modulated signal that contains information pertaining to a page tag.

Claims 6-8 and 35 recite a mark-up language page/page tag, which again can be simply information/code on a piece of paper.

7. To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by No.

2002/0091755 to Narin.

10. As per claim 1, Narin discloses a readable media (Fig. 3) having instructions for displaying information in a display (handheld has browser application that displays markup language on LCD screen), the instructions performing steps comprising: retrieving a mark-up language formatted page containing the information (memory on handheld read and information displayed on LCD); determining if the mark-up language formatted page includes a full screen statement, and if the mark-up language formatted page includes a full screen statement, displaying the information as a full screen within the display (paragraph 45).

11. As per claim 2, Narin discloses a hand-held device (Fig. 3), comprising: a display (Fig. 3, element 301), and a browser application cooperable with the display for displaying a mark-up language page within the display (see summary of invention), the browser application comprising instructions responsive to a full screen statement for causing the mark-up language page to be displayed as a full screen within the display (paragraph 45).

12. Claims 3-5, 6-8, 9-11, 12-25 and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by No. 6,104,334 to Allport.

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13. As per claims 3, 6, 9 and 35, Allport discloses an electrical signal (inherent, data communication in a digital computer system is done with electrical signals), mark-up language page tag (uses HTML to display layout on screen, Column 24, lines 33-44), readable media (memory in device) and a mark-up language page representative (virtual e.g., non-hardware representation, Fig. 3) of a mark-up language page tag, comprising: a first field containing information indicative of an infrared code to be transmitted upon activation of a link displayed on a display (Column 30, lines 9-16 IR commands are issued by an user on a GUI, the GUI being HTML based, Column 24, lines 33-44), and a second field containing information representing a label which is displayed on the display and which is activatable as the link (inherently part of HTML, where there are two fields, link and label of the link to display to the user e.g., `label link here`).

14. As per claims 4-5, 7-8 and 10-11, Allport discloses claims 3, 6 and 9, respectively, wherein the information contained within the first field comprises data for use in generating infrared code (Column 30, lines 55-65, link triggers hardware, inherently with data associated with address of hardware to send code).

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15. As per claims 12, Allport discloses a readable media having instructions for displaying information in a display (Column 24, lines 33-65), the instructions performing steps comprising: retrieving a mark-up language formatted page containing the information and a tag including information indicative of an infrared code to be transmitted upon activation of a link (Column 30, lines 9-16 indicate IR commands accessed on GUI); displaying the mark-up language formatted page and the link in the display (Fig. 15); determining if the link has been activated; and if the link has been activated, transmitting the infrared code to a consumer appliance (Fig. 11, if a link is pressed, e.g., pause song, command is sent to music player consumer application).
16. As per claims 13 and 14, Allport discloses claim 12, wherein the information is indicative of the IR code comprises address/data for use in generating infrared code (Column 30, lines 55-65, link triggers hardware, inherently with data associated with address of hardware to send code and what information/data to send to the hardware).
17. As per claim 15, Allport discloses claim 12, wherein the mark-up language page is representative of a media guide (Fig. 10).
18. As per claim 16, Allport discloses claim 15, wherein link is representative of a television channel (Fig. 5).
19. As per claim 17, Allport discloses claim 15, wherein link is representative of a radio channel (Column 27, lines 9-16).
20. As per claim 18, Allport discloses claim 15, wherein link is representative of a CD track (Fig. 8, element 255).
21. As per claim 19, Allport discloses claim 15, wherein the link is representative of a DVD chapter (Column 16, lines 28-60).

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22. As per claim 20, Allport discloses claim 12, wherein the tag includes information indicative of a label, the label being displayable as a representation of the link (inherently part of HTML, where there are two fields, link and label of the link to display to the user e.g., `label link here`).

23. As per claim 21, Allport discloses claim 12, wherein the mark-up language page depicts a representation of a user interface of a remote control (Fig 3 and Column 24, lines 33-44).

24. As per claim 22, Allport discloses a device (Fig. 3) for use in commands the operation of a consumer appliance (see abstract), comprising: a display (Fig. 2); a memory storing a library of command codes for commanding the operation of a plurality of different consumer appliances (Column 31, lines 11-23); a transmission circuit for transmitting command codes to the consumer appliance (Fig. 18k, lines 675); and a browser application (Column 24, lines 33-44) for displaying a mark-up language page within the display wherein the mark-up language page includes a tag comprising information representing a command code to be transmitted to the consumer appliance upon activation of a displayed link and wherein the browser application is responsive to activation of the displayed link (inherently part of HTML, where there are two fields, link and label of the link to display to the user e.g., `label link here`) to cause the transmission circuit to transmit a command code selected from the library of command codes stored in memory which corresponds to the command code represented by the data included in the tag (Column 30, lines 9-16 and Column 31, lines 10-25).

25. As per claim 23, Allport discloses claim 22, wherein the transmission circuit comprises an infrared transmitter (Fig. 18, elements 640 and 645).

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26. As per claim 24, Allport discloses claim 22, wherein the device comprises a hand-held remote control (Fig. 3).

27. As per claim 25, Allport discloses claim 22 wherein the display comprises a touch screen (Fig. 18, element 660).

28. Claims 26-33 are rejected under 35 U.S.C. 102(e) as being anticipated by No. 6,025,837 to Matthews, III et al. (hereafter Matthews).

29. As per claims 26, Matthews discloses a readable media (Fig. 4) having instructions for displaying information in a display (Fig. 4, element 96), the instructions performing steps comprising: retrieving a mark-up language formatted page (Column 10, lines 10-35) containing the information and a tag representative of a reminder event including a first field containing data representing a date and time and a second field containing data representing a reminder notice (Column 12, lines 30-40 and HTML inherently contains different fields representing the data to display and function of the link when clicked.); registering the reminder event with a reminder function (reminder event is when user sets the time of day to watch a particular future show); determining a time of activation of the reminder function; and comparing the time of activation of the reminder function to the date and time associated with the reminder event to determine if the reminder notice should be displayed in the display (when the time arrives, show is automatically tuned in, Column 12, lines 30-40).

30. As per claims 27-30, Matthews discloses the reminder being "activated" upon the user dragging and dropping the TV show label which is a representative of device handling/key/label/link associated with the device (Column 12, lines 30-40).

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31. As per claim 31, Matthews discloses device (Fig. 4), comprising: a display (Fig. 1, element 24); a browser application for displaying a mark-up language page within the display (Fig. 4, element 106) wherein the mark-up language page includes a tag representing a reminder event having a first field containing data representing a date and time and a second field containing data representing a reminder notice (Column 12, lines 30-40 and HTML inherently contains different fields representing the data to display and function of the link when clicked.); and a reminder function with which the reminder event is registered, the reminder function having instructions for determining its time of activation and for comparing the time of its activation to the date and time associated with the reminder event to determine if the reminder notice should be displayed in the display (when the time arrives, show is automatically tuned in, Column 12, lines 30-40).

32. As per claims 32, Matthews discloses claim 31, wherein the reminder function is activated in response to a sensed movement of the device (Column 12, lines 30, 40, drag and drop is a sensed software movement of the device that activates reminder).

33. As per claims 33, Matthews discloses claim 31, wherein the reminder function is activated in response to activation of input device associated with device (remote control, Fig. 1, element 30 or mouse, Fig. 3, element 32 causes drag and drop which activates reminder).

Conclusion

34. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to browser remote control of appliances:

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U.S. Pat. No. 6,317,885 to Fries


U.S. Pub. No. 20020087402 to Zustak et al.

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan S Chen whose telephone number is 571-272-4143. The examiner can normally be reached on M-F 8:30am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A Gaffin can be reached on (571) 272-4146. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ASC
09/15/2004


KIM HUYNH
PRIMARY EXAMINER
9/17/04